

Remarks

Claims 7-12 are pending in the present application. Claims 7 and 10 have been amended. No new matter has been added. Reconsideration of the present application is requested in view of the amendments and the following remarks.

Claims 7-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner noted that the phrases “this track” and “starting position” are unclear. In response, “this track” has been deleted. Furthermore, any confusion between “starting position” and “current track” has been eliminated by the deletion of “current track.” Accordingly, the indefiniteness rejection has been overcome.

Claim 7 stands rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Yamada (U.S. Patent No. 5,737,284). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 7 has been amended to recite, in relevant parts, “moving the read device in a direction of a lead-in area of the optical storage disk until a predefined starting position is detected, in response to a track skip request; determining a time required for the track skip of the read device from the starting position to the selected track, as a function of tracks to be skipped; and moving the read device for the determined time required for the track skip in a direction of the selected track.” In accordance with the present invention, a track skip operation is performed by initially moving the read device to a predefined starting position and calculating the time required to reach the selected target track from the predefined starting position. Since the starting position is predefined in accordance with the present invention, there is no need to determine the

relative positions (or relative addresses) of the current track and the selected track in order to calculate the number of tracks to be skipped based on the relative addresses. However, in contrast to the present claimed invention, Yamada teaches exactly what the present invention tries to avoid, i.e., use relative addresses to perform a track skip. More specifically, Yamada uses relative addresses in the lead-in area of the disc, absolute addresses in the program area outside the lead-in area, and a reference relative address. The number of remaining tracks between the current track and the selected target track for the track skip operation is calculated based on the address of the target track, the reference relative address and the relative address of the current track of the read device. (Col. 4, lines 61-66). Accordingly, Yamada teaches an arrangement completely different from the present claimed invention as recited in claim 7, which requires "moving the read device in a direction of a lead-in area of the optical storage disk until a predefined starting position is detected, in response to a track skip request," and "determining a time required for the track skip of the read device from the starting position to the selected track, as a function of tracks to be skipped."

For the foregoing reasons, claim 7 and its dependent claims 8-9 are not anticipated by Yamada. Claim 10 recites similar features as those recited in claim 7, so claim 10 and its dependent claims 11-12 are also not anticipated by Yamada. Prompt reconsideration and allowance of the present application are respectfully requested.

The Office is authorized to charge the \$120 fee for a one-month extension of time to respond to the April 13, 2005 Office Action to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully Submitted,
KENYON & KENYON

 (R.M. 36,197)

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